

VIA eFILE

PATENT APPLICATION
Docket No. 13768.1085

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	Gueorgui Bonov Chkodrov, et al.)
)
Serial No.:	10/670,276) Art Unit
) 2166
Confirmation No.:	4935)
)
Filed:	09/26/2003)
)
For:	Method for maintaining information)
	About multiple instances of an activity)
)
Examiner:	Srirama T. Channavajjala)

REPLY BRIEF OF APPELLANTS TO SUPPLEMENTAL EXAMINER'S ANSWER

VIA eFILE Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On March 31, 2009, the Examiner mailed a Supplemental Examiner's Answer ("Supplemental Answer") to respond to Appellant's timely-filed Reply Brief. This Supplemental Reply Brief is being filed under the provisions of 37 C.F.R. § 41.41. This brief is being filed on May 29, 2009 and is therefore timely under 37 C.F.R. § 41.41.

I. INTRODUCTION

Appealed claims 1-46 currently stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter, and under 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 6,477,525 to Bellow et al. ("Bellow") in view of U.S. Publication No.

2003/0217075 of Nakano et al. (“Nakano”) and in further view of U.S. Publication No. 2004/0139061 of Colossi et al. (“Colossi”).

Appellant respectfully submits that the Examiner’s rejection under § 101 is improper because the Examiner continues to fail to properly apply the law and guidelines governing statutory subject matter under § 101. Examiner continues to hold to the mistaken argument that the process must result in an “output, displayed or at least stored to a user” to have a “real-world result.” The focus of this argument in the Supplemental Answer is that such a “real-world result” must be recited in the claims. First, the § 101 statutory requirements merely require that the “real-world result” be in the “disclosure,” not the claims. Second, even if the claims were required to recite the “real-world result,” this requirement is met by each of the independent claims, which explicitly states that the invention “prevent[s] the degradation of response times when database users access the records for the instances in the active condition[.]” (Claims 1, 23, 45). The decreased response time provided by the invention of the claims at issue in this Appeal saves valuable time and resources, which is a desirable and tangible “real-world result” that is recited in the claims and satisfies the “practical application” requirement of § 101.

The Supplemental Answer also raises a new theory for rejecting independent claims 23 and 45, and the claims depending therefrom, under § 101 as non-statutory “software per se.” This rejection by the Examiner is wrong as to claim 23 because that claim recites a tangible computer storage medium. With respect to claim 45, that claim recites a storage device, input device, and processor operatively connected to the storage and input devices. Because both of claims 23 and 45 recite tangible elements, neither claim is “software per se” and the Examiner’s rejection on this ground is baseless.

The Supplemental Answer also re-argues the same rejections under 35 U.S.C. § 103 argued in the Examiner's Answer. Because these arguments have already been addressed in the Appeal Brief and the Reply, Applicant will not reiterate its arguments to those rejections here. Instead, Applicant relies on its arguments overcoming the Examiner's § 103 rejections as set forth in the Appeal Brief and the Reply Brief.

For these reasons, and the additional reasons set forth below and in the Appeal Brief and the Reply Brief, the Examiner's rejections should respectfully be withdrawn and the claims be allowed.

II. ARGUMENT

A. *The Examiner's § 101 Rejection of Claims 1-46 Is Improper Because the Examiner Fails to Recognize that the Limitation "Prevent[s] the Degradation of Response Times when Database Users Access the Records for the Instances in the Active Condition" Is a Real-world Result Sufficient to Satisfy § 101*

1. The § 101 "Real-world Result" Does Not Need to Be Recited in the Claims

Although the Examiner correctly cites the guidelines of MPEP 2106(II)A that an invention must produce a "useful, concrete and tangible result" to qualify as statutory subject matter under § 101, the Examiner erred in applying these guidelines to the claimed invention. The Examiner quotes MPEP 2106(II)A: "The purpose of this requirement is to limit patent protection to inventions that possess a certain level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. Accordingly, a **complete disclosure** should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful." (Examiner's Answer, p. 4. (emphasis added) (citations omitted)). Importantly, the

practical application of a claimed invention need only be set forth somewhere in the “complete disclosure” of the invention. As such, the practical result need not be recited as an element in the claims. The Examiner’s rejection requiring the practical application or “real-world result” to be recited in the claims is wrong as a matter of law, and should be withdrawn. As explained in the Appeal Brief and the Reply Brief, the specification explains that the claims have the real-world result of increasing efficiency of processing requests to the first database table containing instances in the active condition.

2. Each of the Independent Claims Recite the Limitation “Prevent[s] the Degradation of Response Times when Database Users Access the Records for the Instances in the Active Condition” Which Is a Real-world Result Sufficient to Satisfy § 101

Even if the Examiner were correct that § 101 requires the practical application or “real-world result” to be explicitly recited in the claims, which is not correct for the reasons stated above, the claims at issue in this Appeal meet this requirement. This requirement is met by each of the independent claims, which explicitly states that the invention “prevent[s] the degradation of response times when database users access the records for the instances in the active condition[.]” (Claims 1, 23, 45). In laymen’s terms, the claimed invention saves user time and computing resources by decreasing the time needed to access information in record of the active instances. Claims’ recitation of “preventing the degradation of response times” satisfies the “practical application” and “real-world value” requirement of § 101, as explained in Applicant’s Appeal Brief and Reply Brief. As such, the Examiner’s rejection is in error and should respectfully be removed.

3. The Examiner's Rejection of Claims 23-57 as "Software per se" Is Wrong because Those Claims Recite Tangible Elements Sufficient to Satisfy § 101

The Supplemental Answer articulates a new ground for rejecting claims 23-47 under § 101 arguing that those claims are "software per se." (Supplemental Answer at p. 8-12.) The Examiner is simply wrong on the facts. Independent claim 45 claims a "data processing apparatus" comprising "at least one data storage device; at least one user input device; and a process operatively connected to said storage device and said user input device" Because independent claim 45 claims a "data processing apparatus" with the tangible elements indicated above, claim 45 is not "software per se," is not merely an "abstract idea" as argued by the Examiner, and clearly satisfies § 101.

Similarly claim 23 is for a "computer readable medium having stored thereon data[.]" Because claim 23 is for a computer readable storage medium, this claim too is for a tangible invention. If the computer readable medium claimed in claim 23 were not a tangible storage medium, it would not be possible to store data thereon. As such, the invention of claim 23, and the claims depending therefrom, is not "software per se," and is not merely an "abstract idea" as argued by the Examiner. Because claim 23 is for a tangible computer readable storage medium, claim 23 satisfies § 101 and the Examiner's rejection based on this ground should respectfully be removed.

III. CONCLUSION

For the foregoing reasons, and the additional reasons set forth in the Appeal Brief and in the Reply Brief, the Appellant respectfully requests the Board to overturn the Examiner's rejections of the appealed claims 1-46 and to allow these pending claims in their present form.

Dated May 29, 2009.

Respectfully submitted,

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